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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,545	03/28/2001	Ron H. Niswander	43050	5242
7590	12/29/2004			
John W. Jones Locke Liddell & Sapp LLP 3400 Chase Tower 600 Travis Street Houston, TX 77002-3095			EXAMINER KUHN, ALLAN R	
			ART UNIT 1732	PAPER NUMBER
DATE MAILED: 12/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application N .

09/762,545

Applicant(s)

NISWANDER, RON H.

Examiner

Allan Kuhns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 and 18 is/are rejected.  
7) ☒ Claim(s) 17 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

1.The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2.Claims 1, 3, 5-6, 10-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/25985 (Horn et al.) as set forth in the rejection of claims 1, 3, 5-6 and 10-15 in the previous Office action. It is submitted that the IMR enhancing compound of Horn et al. is sufficient to reduce removal force and to permit removal of the article, as in claims 16 and 18, since the translation for this reference discloses the utility of including what is an IMR enhancer compound at column 19, line 15.

3.Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/25985 (Horn et al.) as applied to claims 1, 3, 5-6, 10-16 and 18 above, and further in view of Clatty as set forth in the previous Office action.

4.Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slocum et al. (5,019,317) as set forth in the previous Office action.

5.Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6.Applicant's arguments filed October 11, 2004 have been fully considered but they are not persuasive. Concerning the Horn reference, applicant argues that the instant claims specifically recite "a fatty acid condensation product" and that this requires a reaction where water is formed. The examiner is in agreement that such a

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reaction represents a conventional condensation reaction. But applicant, at page 4, lines 20-21 of the specification, includes as condensation products those which would include a reaction of a fatty acid with an amine, which appears to be taught or suggested by the Horn reference. This is why the examiner has maintained the rejection based on the Horn reference. For this reason, the examiner does not believe that applicant's specification has been misconstrued. Applicant's arguments with regard to ammonia are noted by the examiner, but it appears to the examiner that ammonia was not explicitly discussed in formulating a ground of rejection. Applicant further argues that the fatty acid condensation product in Horn functions as a surfactant, not as an IMR agent. But, to the examiner, since the fatty acid condensation product is present in Horn, it would inherently tend to also function as an IMR agent or enhancer.

Applicant's arguments concerning the Clatty reference are noted by the examiner; the examiner believes that Clatty teaches what it was relied upon to teach.

With regard to Slocum, applicant argues that the organic isocyanate component has already been prepared prior to introduction of the isocyanate reactive component containing zinc carboxylate. But it is the position of the examiner that these claims at issue preclude the formation of a prepolymer. Applicant also questions why one of ordinary skill in the art would conclude that the zinc carboxylate of Slocum would function as an IMR enhancer? One of ordinary skill in the art would come to such conclusion because the Slocum reference touts this composition as one which facilitates the release of a product from a bare metal mold.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (571) 272-1202. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Allan R. Kuhns*

ALLAN R. KUHNS  
PRIMARY EXAMINER AU 1732

12-27-04